

REMARKS

Applicant has carefully studied the Office Action of April 14, 2004 and offers the following remarks to accompany the above amendments.

Applicant initially amends claims 1, 9, and 11 to correct an error that slipped in between the amendment filed April 28, 2003 and the Amendment After Final filed December 19, 2003. Applicant inadvertently deleted a portion of the claim language, namely "with the locality; determining if the locality". Applicant herein reintroduces the language. The scope of the claims should not change, but the inadvertent deletions are corrected.

Claims 1-23 were rejected under 35 U.S.C. § 103 as being unpatentable over Snyder et al. (hereinafter "Snyder") in view of Chern et al. (hereinafter "Chern"). Applicant respectfully traverses. When the Patent Office alleges that a claim is unpatentable over a combination of references, the Patent Office must do two things. First, the Patent Office must advance a motivation to combine the references, and second, the Patent Office must support this motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Applicant acknowledges that most inventions are combinations of known elements. One of the things that makes an invention patentable over the references that contain those known elements is that there is no suggestion to combine the elements in the manner of the invention. *Dembiczak* sets forth the rules under which the Patent Office can combine the references. If the Patent Office cannot combine the references, the references must be considered individually. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located. MPEP § 2143.03. If the Patent Office cannot show where a claim element is located, the Applicant is entitled to a patent.

Regarding claims 1, 12, and 23, the Patent Office admits that Snyder does not teach or suggest "accessing content from the content providers based on the locality by sending a request to a content provider within the locality." Likewise, regarding claims 9, 11, 20, and 22, the Patent Office admits that Snyder does not teach "accessing the content from the content providers based on the locality wherein accessing is based on criteria within the profile such that the criteria further identified a type of content to access." Thus, Snyder alone does not establish *prima facie* obviousness for the independent claims. The Patent Office relies on Chern to supplement the deficient portions of Snyder. Specifically, for claims 1, 3, 12, 14, and 23, the Patent Office opines that Chern teaches accessing content from the content provider based on the

locality by sending a request to a content provider within the locality. Likewise, for claims 9, 11, 20, and 22, the Patent Office opines that Chern teaches accessing the content from the content provider based on the locality wherein accessing is based on criteria within the profile such that the criteria further identified a type of content to access. The reason the Patent Office gives for making this combination is "it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Chern into the system of Snyder so that services can be provided to the user based on what he/she needs." (Office Action of April 14, 2004, page 4, lines 1-3, and page 7, lines 3-5). Applicant traverses this assertion of a motivation. Applicant initially traverses the motivation on the basis that the motivation is not supported with the requisite actual evidence. Without the actual evidence, it appears that the Patent Office has selected these two references with Applicant's disclosure as a template. Such hindsight reconstruction is impermissible, and this impermissible reconstruction makes the combination improper.

Applicant further traverses the motivation as non-compelling. The assertion that the combination provides services to the user based on what he/she needs begs the question of who determines what the user needs. From the perspective of Snyder, Snyder inherently fulfills this need by providing the information about the places of interest near the "que point." Thus, under this analysis, Snyder would not contemplate such a combination because the motivation is satisfied. Likewise, from the perspective of Chern, Chern provides all the information a user needs and would not be combined with Snyder. That is, Chern has a mechanism for determining where the user is and delivering information based on that location. The information is, according to Chern, what the user needs. Thus, Chern likewise, from its own perspective, satisfies the motivation without the need for the proposed combination. Again, it appears that the Patent Office has selected the references with Applicant's disclosure as a template. Such hindsight reconstruction is impermissible, and this impermissible reconstruction makes the combination improper.

Since the combination is improper, the references must be considered individually. As noted above, Snyder admittedly does not teach or suggest a claim element and cannot render the claims obvious. Likewise, Chern does not define the localities recited in the claims. Thus, Chern individually cannot render the claims obvious. Since the references individually do not render the claims obvious, the claims are allowable over the rejection of record.

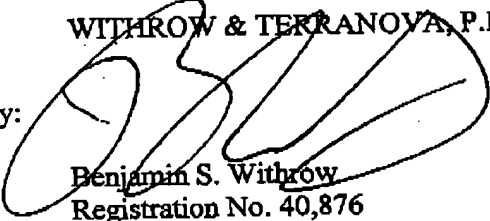
Applicant further traverses the use of Applicant's disclosure in the rejection. Specifically, on pp. 6-7 of the Office Action, the Patent Office references Applicant's specification, page 3, lines 6-8 and page 5, lines 19-20 alleging that these passages disclose a profile created by the user to identify the content or type of content to receive. The Patent Office makes this statement in the context of asserting that Chern teaches profiles. The Patent Office cannot use Applicant's disclosure to reject the claims. The cited passages lie in the Summary of the Invention section and the Detailed Description section of Applicant's specification and do not constitute admitted prior art. To the extent that the Patent Office has relied on Applicant's disclosure to support the rejection, the rejection is improper. If the Patent Office was citing Applicant's disclosure for some other purpose, Applicant requests clarification as to the intent of the citation and reserves the right to address this clarification at a later date.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. Specifically, the combination of references is improper and the references individually do not teach or suggest all the claim elements. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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